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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/062,113 04/17/98 GOTO

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PATENT ADMINISTRATOR  
TESTA HURWITZ & THIBEAULT LLP  
HIGH STREET TOWER  
125 HIGH STREET  
BOSTON MA 02110

EXAMINER

ROMEO, D

ART UNIT

PAPER NUMBER

1646

DATE MAILED:

01/31/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.  
**09/062,113**

Applicant(s)  
**Goto et al.**

Examiner  
**David S. Romeo**

Group Art Unit  
**1646**



☒ Responsive to communication(s) filed on 10 Jun 1999

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 1 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 32-108 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☐ Claim(s) \_\_\_\_\_ is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☒ Claims 32-108 are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☒ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit: 1646

**DETAILED ACTION**

***Election/Restriction***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

Each of Groups I through XXIX is represented by a claim selected from the group

5 consisting of claim 32, 35, 38, 41, 44, 47, 50, 53, 56, 59, 62, 65, 68, 71, 74, 77, 80, 83, 86, 89, 92, 96, 97, 98, 100, 102, 104, 107, and 107, drawn to a polynucleotide comprising the nucleotide sequence of SEQ ID NO:83, 84, 85, 86, 87, 88, 89, 90, 91, 92, 93, 94, 95, 96, 97, 98, 99, 100, 101, 102, 103, 6, 6, 8, 10, 12, 14, 104, 105, respectively, classified in class 536, subclass 23.5.

10 Each of Groups XXX through LVI is represented by a claim selected from the group consisting of claim 34, 37, 40, 43, 46, 49, 52, 55, 58, 61, 64, 67, 70, 73, 76, 79, 82, 85, 88, 91, 94, 95, 99, 101, 103, 105, and 106, drawn to a polynucleotide encoding the amino acid sequence of SEQ ID NO:62, 63, 64, 65, 66, 67, 68, 69, 70, 71, 72, 73, 74, 75, 76, 77, 78, 79, 80, 81, 82, 4, 9, 11, 13, 15, 4, respectively, classified in class 536, subclass  
15 23.5.

Each of Groups LVII through LXXVII is represented by a claim selected from the group consisting of claim 33, 36, 39, 42, 45, 48, 51, 54, 57, 60, 63, 66, 69, 72, 75, 78, 81,

Art Unit: 1646

84, 87, 90, and 93, drawn to a polypeptide encoded by a polynucleotide comprising the nucleotide sequence of SEQ ID NO:83, 84, 85, 86, 87, 88, 89, 90, 91, 92, 93, 94, 95, 96, 97, 98, 99, 100, 101, 102, 103 respectively, classified in class 530, subclass 350.

Group LXXVIII is represented by claim 108 drawn to a polypeptide comprising the amino acid sequence of SEQ ID NO:4, classified in class 530, subclass 350.

2. The inventions are distinct, each from the other because of the following reasons:

The polynucleotides of Invention I through LVI are related to the polypeptides of Invention LVII through LXXVIII by virtue of encoding same. The polynucleotide has utility for the recombinant production of the polypeptide in a host cell. Although the polynucleotide and polypeptide are related since the polynucleotide encodes the specifically claimed polypeptide, they are distinct inventions because they are physically and functionally distinct chemical entities, and the polypeptide product can be made by another and materially different process, such as by synthetic polypeptide synthesis or purification from the natural source. Further, the polynucleotide may be used for processes other than the production of the polypeptide, such as a nucleic acid hybridization assay.

Art Unit: 1646

Each of the polynucleotides, groups I through LVI, are independent and distinct, wherein each is not required for the production or use of the other, and wherein each can be manufactured independently of the other.

Each of the polypeptides, groups LVII through LXXVIII, are independent and distinct,  
5 wherein each is not required for the production or use of the other, and wherein each can be manufactured independently of the other.

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

10 4. Because these inventions are distinct for the reasons given above and the searches required for each of the groups is not coextensive, restriction for examination purposes as indicated is proper.

5. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for  
15 examination purposes as indicated is proper.

6. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Art Unit: 1646

7. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

**Formal Matters:**

8. The preliminary amendment filed 04/17/98 (Paper No. 2) has been entered in part. Claims 1-31 have been canceled and new claims 32-94 have been entered. The amendments to the specification have not been entered.

A substitute specification excluding claims is required pursuant to 37 CFR 1.125(a) because the interlineations or cancellations made in the specification could lead to confusion and mistake during the issue and printing processes. Accordingly, the specification is required to be rewritten before passing the case to issue. See 37 CFR 1.125 and MPEP § 608.01(q).

A substitute specification filed under 37 CFR 1.125(a) must only contain subject matter from the original specification and any previously entered amendment under 37 CFR 1.121. If the substitute specification contains additional subject matter not of record, the substitute specification must be filed under 37 CFR 1.125(b) and must be accompanied by: 1) a statement that the substitute specification contains no new matter; and 2) a marked-up copy showing the

Art Unit: 1646

amendments to be made via the substitute specification relative to the specification at the time the substitute specification is filed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David S. Romeo whose telephone number is (703) 305-4050. The examiner can normally be reached on Monday through Friday from 6:45 a.m. to 3:15 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Kunz, can be reached on (703) 308-4623.

Official papers filed by fax should be directed to (703) 308-4242.

Faxed draft or informal communications should be directed to the examiner at (703) 308-0294.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

*David Romeo*  
**DAVID ROMEO**  
**PATENT EXAMINER**  
January 18, 2000